

REMARKS

Claims 25-47 are pending in this application. Claims 25, 31, 34, and 46 are independent claims. Claims 25, 31, and 34 are amended. Claims 46 and 47 are have been added. Claim 1-24 have been previously canceled. Reconsideration and allowance of the present application are respectfully requested.

Drawings

The drawings filed on February 24, 2007, have been accepted by the Examiner. Therefore, no drawing corrections are required.

Claim Rejections

Rejections Under 35 U.S.C. § 103 – Ito et al

Claims 25-45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,160,778 (“Ito et al.”). This rejection is respectfully traversed.

Ito fails to teach or suggest a “second information including a first pointer pointing to an address where the first information is recorded,” as recited in claim 25. The Examiner references the ‘Disk definition structure’ of Ito as teaching this feature; however, nothing in Ito teaches or suggests that the Disk definition structure contains a pointer pointing to the address where the first information is recorded. Ito is silent as to what the Disk definition structure does or does not contain, or more specifically, as to which addresses, if any, it does or does not point to. Accordingly, Ito does not teach “second information including a first pointer *pointing to an address where the first information is recorded*”, as is required by claim 1.

Next, nothing in Ito teaches or suggests placing the second information in the last sector of the data block as is required by claim 1. The Examiner states “rearranging parts of an invention involves only routine skill in the art” (August 24, 2007 Office Action, pg. 3). However, Section 2144.04 (VI)(C) of the MPEP states:

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design

choice). However, *"The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. **The prior art must provide a motivation or reason** for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device."* Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). (Emphasis added)

The Examiner did not provide any motivation for rearranging the structure taught by Ito to read on the position of the second information in claim 1 and thus, the Examiner's argument, by itself, is insufficient to support a finding of obviousness.

Still further, nothing in Ito teaches "a second management area storing latest data block recorded in the first management area when no further recording can be made on the recording medium" as is claimed in claim 1.

Accordingly, at least for the reasons stated above, Ito does not teach or suggest each of the limitations in claim 25 as amended. Consequently, the Examiner cannot establish a *prima facie* case of obviousness with respect to claim 25 as is required for a rejection under 35 U.S.C. §103.

Amended claims 31 and 34 contain limitations similar to those discussed above with respect to claim 25. Accordingly, the Examiner cannot establish a *prima facie* case with respect to either of claims 31 and 34 as is required for a rejection under 35 U.S.C. §103, at least in view of their similarity to claim 25.

Additionally, claims 26-30, 37, 38 and 43 depend from claim 25; claims 32, 33, 39, 40 and 44 depend from claim 31; and claims 35, 36, 41, 42 and 45 depend from claim 34. Accordingly, the Examiner cannot establish a *prima facie* case of obviousness with respect to any of claims 26-30, 32, 33, or 35-45 as is required for a rejection under 35 U.S.C. §103, at least in view of their dependency from claims 25, 31 and 34.

Therefore, Applicants respectfully request that this rejection of claims 25-45 under 35 U.S.C. §103 be withdrawn.

New Claims

New claims 46 and 47 have been added. The Applicant believes claim 46 to be allowable because it contains limitations similar to those of claim 25, which the Applicant believes to be allowable for the reasons articulated above. The Applicant believes claim 47 to be allowable because it depends from claim 46.

CONCLUSION

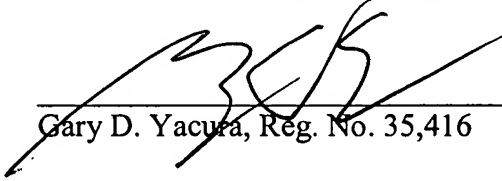
In view of the above remarks and amendments, Applicants respectfully submit that each of the rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,
HARNES, DICKEY, & PIERCE, P.L.C.

By



Gary D. Yacura, Reg. No. 35,416

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

GDY/JHA/mat